

REMARKS

I. PRELIMINARY REMARKS

The undersigned attorney wishes to thank the Examiners for the courtesy of the Interview conducted December 11, 2007.

II. OUTSTANDING REJECTIONS

Claims 25-27, 29, and 31-41 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Claims 25-27, 29, and 31-41 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Policappelli, U.S. Patent No. 5,612,039 ("Policappelli") in view of Lowenstein, U.S. Patent No. 3,764,692 ("Lowenstein").

Claims 25, 26, and 29 stand provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 3-5, 7-9, and 12 of copending Application No. 11/209,429 ("the '429 application").

Claims 25-27, 29, and 31-41 stand provisionally rejected under the judicially created obviousness-type double patenting over claims 1-2, 6, 10-11, and 13-36 of the copending '429 application.

III. PATENTABILITY ARGUMENTS

A. The rejection of all pending claims under 35 U.S.C. §112, first paragraph should be withdrawn

The rejection of all pending claims under 35 U.S.C. §112, first paragraph should be withdrawn because there is support in the specification for double and triple salts of hydroxycitric acid ("HCA"), and therefore, the claims comply with the written description requirement.

The specification discloses double and triple salts. The specification states the "composition comprises approximately 14 to 26% by weight of calcium, and approximately 24 to 40% by weight of potassium or approximately 14 to 24% by weight of sodium, *or a mixture thereof*." Application at p.2, lines 17-19. One of ordinary skill in the art would recognize that calcium and mixtures of potassium and sodium would produce a triple salt with HCA.

Additional support for double salts can be found in the specification at p.4, lines 1-3 and lines 15-16. The specification discloses “a mixture of calcium salt with potassium or sodium salts.” Application at p.4, lines 1-3. In addition, one of ordinary skill in the art would recognize that the synthesis process at p.6, line 9-p.7, line 18 produces a double salt. When calcium hydroxide and potassium hydroxide are added to HCA, one of ordinary skill in the art would know that an acid-base reaction takes place forming a double salt. Therefore, one of ordinary skill in the art would recognize that the process results in a double salt of HCA.

It is submitted that this rejection can be withdrawn.

B. The rejection of all pending claims under 35 U.S.C. §103(a) should be withdrawn

The rejection of all pending claims under 35 U.S.C. §103(a) should be withdrawn because the mixed cation salt of HCA is not obvious in light of the references. The references, Lowenstein and Policappelli, do not teach or suggest all the claim limitations. Each reference teaches single cation salts of HCA. Policappelli merely recites a calcium salt of HCA. Policappelli at col. 5, lines 66-67. Lowenstein merely recites various single cation salts of HCA. Lowenstein at col. 2, lines 1-8. Neither discloses or suggests a double or triple salt of HCA.

Additionally, secondary considerations, such as unexpected results, must be considered when discussing obviousness. The present invention of the mixed cation salt of HCA produces unexpected results. The mixed cation salt of HCA has better solubility, hygroscopicity, and palatability properties than the single cation salts disclosed in the prior art. Each single cation salt of HCA is problematic for use in dietary supplements. Calcium salt of HCA has poor solubility, reducing bioavailability, and potassium salt of HCA is highly hygroscopic, reducing shelf life. There is no indication in the prior art that calcium and potassium and/or sodium salts of HCA have high solubility and low hygroscopicity. Therefore, the unexpected properties, increased bioavailability and minimal hygroscopicity, of the mixed cation HCA salt show that the combination is not obvious.

Furthermore, the Action states that “the references are silent with respect to the properties of instant claims 35-37.” Action at p.4. Those claims recite the characteristics of the composition, including odor, taste, and color. However, the references are not silent on

the properties of the composition. Policappelli lists the characteristics of calcium salt of HCA. While the composition of the present invention has negligible odor, taste, and color, calcium salt of HCA has a “characteristic smoky-herbal” odor, a “characteristic salty-herbal” taste, and a “light tan” color. Policappelli at col. 6, lines 7-9. Therefore, the assumption that the compositions of the references and the present invention are the same cannot be supported because the properties are different.

Finally, this combination of salts leads to better bioavailability and shelf life for dietary supplements, a true improvement in the area of dietary supplements. Therefore, it is submitted that this rejection can be withdrawn.

C. The provisional rejection under 35 U.S.C. §101 should be withdrawn

The provisional rejection of claims 25, 26, and 29 under 35 U.S.C. §101 should be withdrawn because the claims of the patent application are not identical to those in the copending Application No. 11/209,429 (‘429).

Claim 25 recites a different range of sodium than any claim in ‘429. Claim 26 recites a different weight percent for hydroxycitric acid and a different range for sodium than any claim in ‘429. Claim 29 depends from claim 25 which does not have an identical match in the ‘429 application. Therefore, the claims are not identical and the rejection should be withdrawn.

D. The provisional rejection under the judicially created obviousness-type double patenting should be deferred

Because this is a provisional rejection, applicants will address these rejections if and when they mature.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Dated: February 7, 2008

Respectfully submitted,

By 
Jeffrey S. Sharp

Registration No.: 31,879
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicant